

REMARKS

Reconsideration is respectfully requested in view of any changes to the claims and the remarks herein. Please contact the undersigned to conduct a telephone interview in accordance with MPEP 713.01 to resolve any remaining requirements and/or issues prior to sending another Office Action. Relevant portions of MPEP 713.01 are included on the signature page of this amendment.

Applicants' claim of priority is correctly stated in the prior response submitted 7/1/2003 at page 3 thereof.

Claims 1-15 and 44-58 have been rejected under 35 USC 112, first paragraph. Applicants respectfully disagree. The only reason for rejection given by the Examiner is that claims 5 and 48 recite "a decoupling capacitor". Claim 5 is an original claim which recites "decoupling capacitor". Thus, the originally submitted specification supports decoupling a capacitor.

The Examiner states "it is unclear what is the function of this capacitor and how this capacitor is interrelated with the instant test probe. Therefore, the operation of this test probe is not well understood".

In the art of electronic probes and substrates for electronic devices the function of decoupling capacitors are well known. See, for example, US Patent 4,734,819 entitled "Decoupling Capacitor For Surface Mounted Leadless Chip Carrier, Surface Mounted Leaded Chip Carrier And Pin Grid Array Package" and US Patent 4,835,464 entitled "Decoupling Apparatus For Use With Integrated Circuit Tester". Thus a person of skill in the art knows how to use a decoupling capacitor as taught and claimed by Applicants.

Without referring to a claim the Examiner states "Furthermore, it appears that the limitation of 'wherein said second contact locations have an elongated conductor attached thereon' does not have support in the specification". This is shown, for example, but not limited thereto, in Fig. 11 which shows contact location 70 with elongated electrical conductor 74 attached thereon.

Claims 4, 51 and 58 are rejected under 35 USC 112, second paragraph. The Examiner states "In claim 4, it is unclear what 'a protuberance' represents." The first full paragraph of page 7 of the specification states "The probe tip is enlarged (13)". This is exemplary only and not limiting. In regards to claim 51 the Examiner states "it is unclear what 'an elongated conductor' represents". For example, Fig. 3 shows elongated conductor 17 and Fig. 11 shows elongated conductor 74. Fig. 11, for example (but not limiting), shows second contact location 70. Claim 58 has been amended to change "said work piece" to "a work piece".

The Examiner incorrectly states that the priority date of the present application is 11/23/1998. As stated above Applicants' priority date is 04/30/1993.

The term "decoupling capacitor" is an original claim 5 of parent application 09/198,179 now US Patent 6,332,270.

The 102(b) and 103(a) rejections over Motooka et al, and Khandros are improper since the effective dates of the references are after Applicants' priority date.

In view of the changes to the claims and the remarks herein, the Examiner is respectfully requested to reconsider the above-identified application. If the Examiner wishes to discuss the application further, or if additional information would be required, the undersigned will cooperate fully to assist in the prosecution of this application.

Please charge any fee necessary to enter this paper and any previous paper to deposit account 09-0468.

If the above-identified Examiner's Action is a final Action, and if the above-identified application will be abandoned without further action by applicants, applicants file a Notice of Appeal to the Board of Appeals and Interferences appealing the final rejection of the claims in the above-identified Examiner's Action. Please charge deposit account 09-0468 any fee necessary to enter such Notice of Appeal.

In the event that this amendment does not result in allowance of all such claims, the undersigned attorney respectfully requests a telephone interview at the Examiner's earliest convenience.

MPEP 713.01 states in part as follows:

Where the response to a first complete action includes a request for an interview or a telephone consultation to be initiated by the examiner, ... the examiner, as soon as he or she has considered the effect of the response, should grant such request if it appears that the interview or consultation would result in expediting the case to a final action.

Respectfully submitted,

By: 

Dr. Daniel P. Morris, Esq.
Reg. No. 32,053
Phone No. (914) 945-3217

IBM Corporation
Intellectual Property Law Dept.
P. O. Box 218
Yorktown Heights, New York 10598